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Supreme Court of the United States

October Term, 1956

No. 988 85

GUSTAV H. BOBERTZ, JR., *Petitioner,*

v.

GENERAL MOTORS CORPORATION, *Respondent.*

REPLY BRIEF FOR THE PETITIONER IN SUPPORT OF HIS PETITION FOR WRIT OF CERTIORARI

GREGORY S. DOLGORUKOV
407 Fisher Building
Detroit 2, Michigan
Attorney for
Petitioner

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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CHARACTER OF THE CASE

This case presents a conflict between two United States Circuit Courts of Appeal on the question of procedural due process in adjudication of patent causes. The presence of such conflict is in no way diminished by the fact that the conflicting decisions on such question were not rendered on the same patent.

There are now two United States Circuit Courts of Appeal, the Sixth Circuit and the Ninth Circuit, having opposite policies and procedures with respect to adjudicating validity of patents. The Court of

Appeals for the Sixth Circuit authorizes adjudication of validity of patents on the prior art without trial after consideration of documents in chambers, while the Court of Appeals for the Ninth Circuit holds that any tendency to abolish trial in patent cases for consideration of documents *in camera* should be curbed. This conflict has serious public consequences and should be resolved.

Allegations of Respondent's Brief (p. 6) That It Supported Its Motion for Summary Judgment by "Self-proving Documents Which Have Not Been, and Could Not Be, Contradicted In Any Manner by the Petitioner" Are in Conflict With the Record.

In justification of such sweeping statement to this Court, respondent's brief gives a list of such supporting evidence, including, in the main, six (6) items of alleged anticipating prior art and three (3) supporting affidavits of its employees, which affidavits are expressly described as "uncontroverted" (p. 5).

(a)

The "uncontroverted" affidavits of respondent's employees Thorpe and Hirshman, presenting as exhibits a large number of photographs alleging them to be "truly showing" the subject-matter (D.R. 55b),* were controverted by the opposing affidavit of the petitioner Gustav H. Bobertz, Jr. (Pl. R. 53a-54a) as follows:

> "4. I have examined affidavits of Stanley C. Thorpe and George Hirshman, and I find that photographs of the accused hood identified as

* The abbreviations "Pl.R." and "D.R." are used herein to designate plaintiff-petitioner's and defendant-respondent's appendices, respectively.

'Hirshman Affidavit Exhibits 8, 9, and 10' are either accidentally or intentionally taken after certain constructional elements material to the issues of the case and originally existing in the hood had disappeared through deformation of the plastic because of usage or the said photographs identified as 'Hirshman Affidavit Exhibits 8, 9, and 10' were accidentally or intentionally taken with such illumination exposures and at such angles as to make the configuration of the hood and particularly of some essential structural elements thereof covered by the claims, either as completely absent or not clearly appearing; that Hirshman affidavit Exhibit 11 *represented in said affidavit as a photograph truly showing* the transparent plastic hood mounted upon the 1949 Oldsmobile, *does not, in fact, represent truly the same, . . .* " (Italics ours).

(b)

Each and every item of the prior art relied on by the respondent in its motion for summary judgment was contradicted by the opposing affidavit of petitioner's expert Tjaarda, an automobile designer and stylist of world renown, who, at the beginning of his career, was employed by the respondent General Motors Corporation "in charge of design of the Art and Color Section". Tjaarda stated in his opposing affidavit (Pl.R. 57a):

"10. I have also carefully examined the disclosures contained in the documents enumerated in page 3 under the headings '(1), (2), (3), (4), and (5)' of the document entitled 'Defendant's Motion for Summary Judgment on Ground of Non-infringement and Invalidity' in the present litigation and find that *none of said disclosures* teaches even a skilled body designer how to produce a display engine hood disclosed and claimed

in the above identified U. S. Patent No. 1,911,600, and that these documents show either automobiles with their original steel hoods having windows provided in them, which *do not have* the same advantages as the all plastic hood disclosed in the patent; or disclose *covers used for engines on chassis displays* which need not complete or carry out the lines of the body design and *do not solve the problems solved in displaying complete automobiles by the hood disclosed by the patent in suit;* U. S. Patent No. 1,045,152 to Kelsey showing a flying machine with transparent hatch cover intended to cover the pilot and not the engine, is equivalent of a door, *does not* relate to displaying automobiles, and is wholly impertinent to the issues of this case; the German patent No. 379,379 to Rumpler does not relate to displaying automobiles, and whatever engine hood is referred to in said patent *does not* have the combination of structural elements disclosed and enumerated in the U. S. Patent No. 1,911,600 in suit; said patent merely states the problem of use of plastics in automobile bodies but wholly fails to give any solution for it, and has no more useful teaching than a statement 'make entire Empire State Building out of plastic' would have. In studying defendant's submitted translation of said German patent No. 379,379 I also notice certain material inaccuracies in translation." (Italics ours)

With respect to the file wrapper of the patent in suit and the prior art cited against petitioner's application during prosecution thereof, Tjaarda's affidavit stated (Pl.R. 57a):

"9. I have carefully studied the U. S. Patent No. 1,911,600 issued May 30, 1933, for Automobile Hood to Gustav H. Bobertz, Jr. and Timothy J. LaFontaine, as well as a complete certified copy

of the record of prosecution of said patent in the U. S. Patent Office, together with the references cited against said application during prosecution thereof; as a result of said study, I find that none of the references cited against said application disclosed an automobile hood comprising in combination the constructional elements disclosed in this patent enumerated by the claims of said patent, or equivalents of such elements."

Respondent's physical exhibit—accused display hood—was objected to as improper and misleading in both of the opposing affidavits (Pl.R. 52a and 58a). Respondent also presented a sample of conventional steel hood improperly stripped of many of its parts, thus leading the Court into the mistaken belief that this was a case of mere "substitution of materials". Neither hood was operative for the purposes of the other.

(c)

The very photograph on p. 3b of respondent's brief to this Court was contradicted by the opposing affidavit of Tjaarda as quoted above and is an example of a transparent engine cover wholly inoperative for the purposes of the invention.

This cover has glass panels not only at top and both sides but also in *front*. Therefore, because of the operation of the *laws of physics governing transparency and reflection*, this cover will always have one of its panels transparent and *can never give the effect of total non-transparency which is necessary to complete the body lines of the exhibited automobile*, as attained by the petitioner's hood at certain desired angles of observation.

Petitioner could prove this physical phenomenon by demonstrating a simple physical exhibit.

Petitioner's answer to respondent's motion for summary judgment denied every material allegation of fact made by the respondent, and the facts material to the issue of validity of the patent in suit were in sharp dispute.

CONCLUSION

Because of the rapid concentration of control taking place in the automobile industry, invalidation without trial of patents of suppliers manufacturing for that industry may greatly accelerate the process of such concentration.

Invalidating patents of these suppliers may not have the effect of releasing the patented subject-matter for the free use of the public. Because of the extremely limited number of outlets open for the products of such manufacturers, such invalidations may operate in many cases for the sole benefit of a single concern and enable it, in effect, to derive high profits from the investment of capital made by others.

The uncertainty as to whether or not such a manufacturer-supplier would be entitled to defend validity of his patent by evidence at a trial should the respondent charge that the patent covers a "simple" invention, may operate to prevent resort to courts by such manufacturer-suppliers for defense of their patent rights, and may put the respondent in a position of practical control of a large aggregate investment made by thousands of small and medium size manufacturers, without the necessity of owning any of their corporate stock.

The respondent was, in effect, rapidly moving toward acquiring substantially similar control over its dealers by holding the power of cancelling dealers' franchises virtually at will. At the outset of the public consideration of that particular matter, the respondent similarly attempted to brush it aside as the grumblings of one dissatisfied dealer not worthy of anyone's attention.

The reasons for granting this petition are of public importance, and the petition should be granted.

Respectfully submitted,

GREGORY S. DOLGORUKOV
407 Fisher Building
Detroit 2, Michigan
Attorney for
Petitioner